REMARKS

Upon entry of the present amendment, claims 1-12 are pending in the application and claims 13-15 and 23-28 are withdrawn.

Claims 1 has been amended.

No claims have been added or canceled.

No new matter has been introduced by the foregoing amendment.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. Rejection under 35 U.S.C. §112.

Claim 1 has been amended to recite "a subsequent application" instead of "the subsequent application".

Regarding the term "higher", Applicants respectfully assert that "higher" is not indefinite. In determining whether a claim is indefinite under Sec. 112, second paragraph, one must determine "whether those skilled in the art would understand what is claimed." *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1217, 18 U.S.P.Q. 2d 1016, 1030 (Fed Cir.), cert denied, 502 U.S. 856 (1991). The proper standard for indefiniteness is whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. *Seattle Box Co. v. Industrial Crating and Packing, Inc.*, 731 F.2d 818, 826, 221 U.S.P.Q. 568, 573-574 (Fed. Cir. 1984).

Applicants respectfully assert that the specification properly discloses the appropriate concentration of the claimed pigment preparation and materials derived therefrom. See, for example, application as filed, page 11, lines 4-6, page 14, lines 1-9, and page 18, lines 19-25.

Therefore, contrary to the Examiner's allegation, "higher" is not indefinite when read in view of the specification, at least because one with ordinary skill in the art would

be able to readily determine the "higher" concentration in light of Applicants' disclosure about the appropriate concentration level.

Withdrawal of this rejection is respectfully requested.

2. **Rejection of claims 1-2, 4-7, and 12 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,168,895 to Metz et al., hereafter "Metz", and by United States Patent No. 4,234,466 to Takahashi et al., hereafter "Takahashi".**

Metz teaches an azo pigment of the formula (1), which has a specific surface area of the pigment powder of more than 45 m^2/g. (Metz, abstract). Typical powder coating resins employed are epoxy resins, polyester resins containing carboxyl and hydroxyl groups, polyurethane resins and acrylic resins, together with the conventional curing agents. Combinations of resins are also used. (Metz, column 5, lines 54-58). The pigment is incorporated homogeneously--for example by extrusion or kneading--at a concentration of from 0.01 to 50% by weight, preferably from 0.5 to 20% by weight and particularly preferably from 0.1 to 5.0% by weight, based on the total mixture, into the binder. (Metz, column 16, lines 26-31).

Takahashi teaches a process for preparing a solid pigment dispersed composition which comprises subjecting a liquid composition comprising at least one ethylenically unsaturated polymerizable compound, at least one resin dissolved or dispersed therein and at least one pigment dispersed therein to suspension or bulk polymerization, if necessary, with previous color matching. (Takahashi, abstract).

In contrast, Applicants' independent claim 1 is directed to a solid pigment preparation comprising (A) at least one pigment in a higher concentration than that which corresponds to a subsequent application and (B) at least one carrier material selected from the group consisting of oligomers and polymers which have a glass transition temperature > 30°C and a melting point or melting range below their decomposition temperature. Applicants' solid pigment preparation is prepared by dispersing the pigment or pigments (A) or the pigment or pigments (A) and at least one constituent (D) in the melt of the carrier material or carrier materials (B) or in the melt of the carrier material or carrier materials (B) and at least one constituent (D) for from 0.5 to 5 hours in a

discontinuously operating dispersing apparatus with a power input of from 0.1 to 1.0 kW/kg, and then discharging the mixture (A/B) or (A/B/D) from the dispersing apparatus and allowing it to cool and solidify.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

In making the instant rejection, the Examiner relies on *Thorpe* as basis for disregarding Applicants' product-by-process limitations. However, Applicants respectfully submit that the holding in *Thorpe* has been misapplied to the instant facts. Indeed, it is submitted that *Thorpe* supports the patentability of the instant claims.

For example, *Thorpe* holds that "if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 77F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985) (citations omitted, emphasis added). Therefore, in view of *Thorpe*, the patentability of a product does indeed depend on its method of production if the product in the product-by-process claim is different or unobvious from a product of the prior art.

Independent claim 1 is directed to a solid pigment preparation. A solid pigment preparation can be characterized according to several properties, including gloss. If two pigment preparations comprising the same constituents at the same weight percentage have substantially different gloss values, it can be deduced that the two pigment preparations are different.

Applicants respectfully assert that two compositions comprising a pigment and a carrier material and consisting of exactly the same components in the same weight percentage (wt%), when one is formed into a pigment preparation using a conventional technique, and the other is formed into a pigment preparation according to Applicants' independent claim 1, the two pigment preparations thus produced are substantially different. This is evidenced, for example, in Applicants' Inventive Examples 1-3 when

compared to Applicants' Comparative Examples 1-3. Some of the data is tabulated below for the convenience of the Examiner.

	Pigment-titanium dioxide Rutile 2310 (wt%)	Carrier material-URALAC 3495 (wt%)	Gloss
Inventive Example 1	67.5	32.5	88
Comparative Example 1	67.5	32.5	70

	Pigment-HOSTAPERM Yellow H4G (wt%)	Carrier material-URALAC 3495 (wt%)	Gloss
Inventive Example 2	50.0	50.0	69
Comparative Example 2	50.0	50.0	33

	Pigment-IRGALITH Blue PDS 6 (wt%)	Carrier material-URALAC 3495 (wt%)	Gloss
Inventive Example 3	50.0	50.0	68
Comparative Example 3	50.0	50.0	47

It can be seen from the above data that the properties of the pigment preparations produced according to Applicants' independent claim 1 are substantially different, as evidenced by the gloss values. Two products can not be the same when they have different properties. Therefore, Applicants have demonstrated that the product, produced according to Applicants' product-by-process claim, is **not** the same as or obvious from that of the product of the prior art, and **is** indeed **different**. According to *Thorpe*, this is at least sufficient for the product-by-process claim to be given patentable weight.

Therefore, Applicants respectfully assert that the limitation "prepared by dispersing the pigment or pigments (A) or the pigment or pigments (A) and at least one constituent (D) in the melt of the carrier material or carrier materials (B) or in the melt of

the carrier material or carrier materials (B) and at least one constituent (D) for from 0.5 to 5 hours in a discontinuously operating dispersing apparatus with a power input of from 0.1 to 1.0 kW/kg, and then discharging the mixture (A/B) or (A/B/D) from the dispersing apparatus and allowing it to cool and solidify" carries considerable patentable weight.

Since neither Takahashi nor Metz teach this limitation, then neither Takahashi nor Metz anticipate the present claims.

Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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